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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

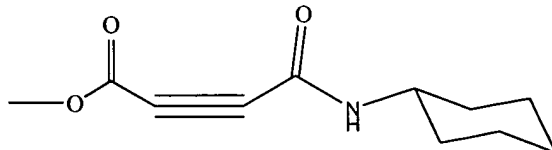
APPLICANT(S) : David J. Austin, et al.  
SERIAL NO. : 10/705,483  
FILED : November 11, 2003  
FOR : Compounds and Methods for Treating Tumors, Cancer and  
Hyperproliferative Diseases

GROUP ART UNIT : 1625  
Examiner : Amelia A. Owens

Mail Stop: Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia, 22313-1450

**Election of Invention in Response  
to Restriction Requirement**

In response to the Examiner's correspondence dated April 11, 2005, pursuant to the Examiner's restriction requirement in the above-referenced patent application, Applicants provisionally elect with traverse to prosecute the invention of group I, namely claims 1-26 (in-part), which are drawn to alkyne (acetylenic) compounds and their pharmaceutical compositions, classified in class 585, subclass 1+. Applicants request that the Examiner withdraw her requirement for a single species inasmuch as the elected invention is directed to compounds sharing a single structural feature (an acetylenic group) have two substituents  $R^1$  and  $R^2$  all of which have a common utility. Consequently, it is respectfully submitted that the elected invention meets the requirements of *In re Harnich* and *Ex parte Hozumi*. Notwithstanding Applicants' election, Applicants also provisionally elect with traverse to prosecute a species according to the chemical structure:



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Applicants respectfully traverse the Examiner's requirement for restriction. Applicants respectfully request the Examiner reconsider her restriction requirement in its entirety. Applicants respectfully submit that prosecution of all of previously elected claims without regard to the imposed restriction will allow the Examiner to examine all claims without being subjected to an undue burden as discussed hereinbelow.

According to M.P.E.P. §803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a *serious burden* would be placed on the Examiner if restriction was not required. Applicant respectfully submits that the presentation of the originally filed claims would not place such a serious burden on the Examiner as to require restriction. All of the originally restricted claims are directed to patentably distinct chemical compounds/compositions or methods of using these compounds/compositions which would not impose a heavy burden of examination on the part of the Examiner.

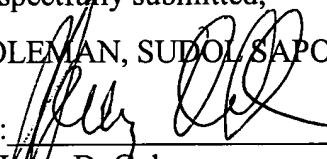
Thus, it is Applicants' view that any search the Examiner would need to conduct in examining the instant application of all the claims would not be unduly burdensome. That would not be to say that the examination would not be rigorous or even time-consuming, but that such effort would not meet the requirements of MPEP§803. This is evidenced by the Examiner indicating that the searches for the examination of all the claims of the instant application *fall within three classes, namely 585, 549 and 514*. Moreover, the examination of all of the originally filed claims in the instant application would not place such a serious burden on the Examiner as to require restriction.

Applicants understand the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicants wish the Patent Office examine their patent application with a certain degree of

"administrative efficiency" and wish to have patent claims issue which reflect the breadth of their invention.

Applicants respectfully submit that the originally filed claims are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in M.P.E.P. §803. Consequently, Applicant respectfully requests that the Examiner withdraw the restriction requirement. Alternatively, in the interest of administrative efficiency, Applicants respectfully request that the Examiner extend consideration to examining claims 1-26 with respect to the invention of group I, without further limiting such examination to a single species.

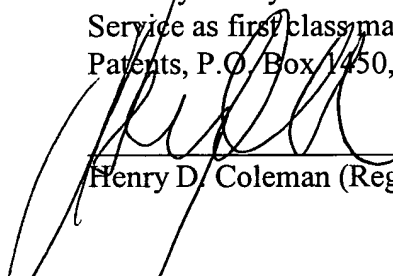
The Examiner is cordially requested to call the undersigned attorney if the Examiner believes that a telephonic discussion may materially advance the prosecution of the instant application in any way.

Respectfully submitted,  
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Dated: May 4, 2005

#### Certificate of Mailing

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia, 22313-1450, dated May 5, 2005.

  
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